



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

9/Response
Lounan
3/30/03

In re Application of:

Daniel I. Kerpelman et al.

Serial No.: 09/470,554

Filed: December 22, 1999

For: INTEGRATED INTERACTIVE
SERVICE TO A PLURALITY OF
MEDICAL DIAGNOSTIC
SYSTEMS

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Group Art Unit: 3626

Examiner: Morgan, Robert W.

Atty. Docket: GEMS:0066/YOD
15-SV-5374

Assistant Commissioner
for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING 37 C.F.R. 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:	
March 17, 2003	<i>Helen Tinsley</i>
Date	Helen Tinsley

**RESPONSE TO FINAL
OFFICE ACTION MAILED JANUARY 23, 2003**

RECEIVED

MAR 28 2003

GROUP 3600

Dear Sir:

In the Final Office Action mailed on January 23, 2003, claims 1-32 were rejected for the same reasons set forth in Office Action dated September 10, 2002. Specifically, claims 1-13 and 15-32 were rejected under 35 U.S. §103(a) as being unpatentable over Wong et al. (U.S. Pat. No. 6,260,021) in view of Ballantyne et al. (U.S. Pat. No. 5,867,821). Furthermore, claim 14 was rejected under 35 U.S. §103(a) as being unpatentable over Wong et al. (U.S. Pat. No. 6,260,021) in view of Ballantyne et al. (U.S. Pat. No. 5,867,821) and Official Notice. The Applicants respectfully traverse these rejections. All pending claims are believed to be clearly patentable for the reasons summarized below.

First Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 1-13 and 15-32 under 35 U.S. §103(a) as being unpatentable over Wong et al. (U.S. Pat. No. 6,260,021) in view of Ballantyne et al. (U.S. Pat No. 5,867,821). The Applicants respectfully traverse Examiner's rejections.

The Examiner is again reminded that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Each of the independent claims 1, 16, and 25 recites a service request or a data communications control system, which are terms described and defined throughout the present application. In an application, an applicant may be his or her own

lexicographer as long as the meaning assigned to the term is not repugnant to the term's well-known usage. *In re Hill*, 73 U.S.P.Q. 482 (C.C.P.A. 1947). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Under M.P.E.P. §2111.01, when the specification provides definitions for terms appearing in the claims, the specification should be used in interpreting claim language. *In re Vogel*, 164 USPQ 619, 622 (C.C.P.A. 1970). Thus, the terms "service request" and "data communications control system," have a special meaning in the claims.

As the Examiner rejected each of the independent claims 1, 16, and 25 under the same proposed combination of prior art, these claims will be discussed together. The Wong et al. and the Ballantyne et al. references, alone or in the proposed combination, fail to disclose at least one of the recited features of each of these claims. For example, as discussed in the previous Response to Office Action dated November 11, 2002, which arguments are hereby incorporated herein by reference, Wong et al. and the Ballantyne et al. fail to disclose or teach "a service request," "a data communications control system coupled to a plurality of diagnostic systems," and "a plurality of medical diagnostic systems coupled to an internal network" of a medical diagnostic facility. Applicants have included additional arguments below in rebuttal of the Examiner's assertions in the Response to Arguments. Furthermore, as discussed in the previous Response to Office Action dated November 11, 2002, which comments are also incorporated herein by reference, the Examiner has provided no sufficient suggestion or motivation to combine these references. Again, Applicants have included additional arguments in view of the Examiner's assertions for the motivation to combine the references in the Response to Arguments.

A “service request” is not equivalent to a “request for an image file.”

The Wong et al. and the Ballantyne et al. references do not disclose “a service request,” as recited in the claims. In the Response to Arguments, the Examiner, again, asserted that the Wong et al. reference discloses a medical image request from a user that is equivalent to a *service request*. Applicants respectfully traverse this assertion.

As discussed above, the term, “service request,” is described throughout the present application. The *service requests* or *data requests* include both requests for maintenance or servicing of the system, requests for information, requests for documentation, requests for examination of protocols, requests for software upgrades, and so forth. See, e.g., Application, page 3, line 25 to page 4, line 2. The *service requests* or *service data* may be exchanged with a service system 62, which may provide reports or analysis of operational or parameter data. See, e.g., Application, page 8, lines 10-24. Accordingly, the *service request*, as defined in the present application, is not equivalent to simple image request from a user, but has a special meaning in the claims.

The Wong et al. reference does not teach operational aspects or anything even related to service within the reference. In the Response to Arguments, the Examiner continues to assert that the request for a medical image is equivalent to a *service request*. Yet, the Wong et al. reference does not support this assertion because the reference is simply directed to providing uniform medical images. Wong et al., col. 1, lines 6-11. Specifically, the problem disclosed in the Wong et al. reference is related to the presence of a variety of medical image distribution systems, and a lack of uniform access of stored images from generated from the systems. Wong et al., col. 2, lines 17-67. Indeed, the reference specifically describes the requests as medical image requests, not a *service request* as claimed. Wong et al., col. 4, lines 1-7. Clearly, the distributing of medical images is not a *service request* as recited in the claimed subject matter.

The Ballantyne et al. reference fails to cure the deficiencies of the Wong et al. reference with regard to “a service request.” The Applicants have reviewed the reference, but it is believed to be absolutely devoid of any teaching or suggestion of “a service request,” as recited in claims. The Ballantyne et al. reference is directed to a method of distributing healthcare information, such as medical records, educational information, and entertainment services. The reference fails even to disclose a *medical diagnostic system*, which is recited in the claims as generating the *service request*. With the reference failing to disclose *diagnostic systems*, the Ballantyne et al. reference cannot disclose or teach a *service request*, as recited in the present claims. Accordingly, the Wong et al. and the Ballantyne et al. references fail to disclose or suggest “a service request,” as recited in the claims.

A “data communications control system” is not equivalent to the “communication controller” of Ballantyne et al.

The Wong et al. and the Ballantyne et al. references do not disclose an “a data communications control system,” as recited in the claims. In the Office Action dated September 10, 2002, the Examiner admitted that the Wong et al. reference fails to disclose a *data communications control system*. In the Response to Arguments, the Examiner, again, appears to assert that the claimed *data communications control system* is equivalent to the communication controller 26 of the Ballantyne et al. reference. Applicants respectfully traverse this assertion.

As discussed above, the term, “data communications control system,” is described throughout the present application. According to the application, the data communications control system (“DCCS”) 40 may be coupled to network 20 to receive or access data from a client, and exchange data with one or more remote service or data providers, which may permit the DCCS 40 to optimize the use of available bandwidth. Application, page 7, lines 13-17. The DCCS 40, as shown in Fig. 2 and as defined in the associated description, may include a central processing

unit 86, a communications interface 88, a memory circuit 92, applications 100, peripheral devices 96, and a software suite 108. Application, page 10, line 1 to page 11, line 12. The DCCS 40 may also include software for associating collected data from the diagnostic systems, and may handle servicing needs of diagnostic systems. Application, page 11, line 14-26. Further, additional applications or software routines may preferably be included in the DCCS 40, which may include diagnostic and service routines, interactive service routines, and may permit service requests to be generated for transmissions to the remote service provider in an interactive manner. Application, page 11, line 29 to page 12, line 22. The functionality of the DCCS 40 is further described through the flow charts in Figs. 4-9. Thus, the term, "data communications control system" or "DCCS," is clearly defined within the Application and has a special meaning in the claims.

As the Examiner admitted that the Wong et al. reference does not disclose the *data communications control system*, the recited feature must be found in the Ballantyne et al. reference for the rejection to stand. The Applicants have reviewed the reference, but it is believed to be absolutely devoid of any teaching or suggestion of any semblance of a "data communications control system," as recited in claims. Again, the Ballantyne et al. reference is a method of distributing healthcare information, such as medical records, educational information, and entertainment services. In Ballantyne et al., the communications controller 26 is coupled to the *internal network*, not to an internal network and to a remote service provider, as recited in the claims. Ballantyne et al., col. 5, lines 6-12. The communication controller 26 is responsible for network channel controller and is described as only being related to the network. Ballantyne et al., col. 5, lines 7-9. Clearly, the communications controller is not equivalent to the *data communications control system* because the communications controller is limited to networking. Accordingly, the Wong et al. and the Ballantyne et al. references fail to disclose or suggest "data communications control system," as recited in the claims.

The references provide no motivation or suggestion to combine.

Assuming, *arguendo*, such combination of Wong et al. and the Ballantyne et al. were even possible, or that this combination would include all of the claimed elements, the Examiner has failed to point to a convincing suggestion or motivation that would lead one skilled in the art to modify the Wong et al. reference or the Ballantyne et al. reference as proposed. The Examiner simply stated that:

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to include the communication controller as taught by Ballantyne et al. within the medical image distribution system as taught by Wong et al. with motivation [sic] of assisting the user with processing a service request, thereby providing a simpler and quicker way to access desired data over a network.

Further, in the Response to Arguments of the present Office Action, the Examiner stated:

In addition, the Examiner respectfully submits that the motivation to combine the applied references is supported by motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness.

That will not do. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999). A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter.

1993). Further, an obviousness rejection may not stand if there is no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). As a result, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990).

In the present case, the Examiner's unsupported assertions do not meet the evidentiary standard required for combining references under Section 103. The Examiner asserts that the logical reasoning of one skilled in the art at the time of the invention supports the combination. However, as discussed above, the references fail to disclose various elements and do not support the combination. Indeed, the Examiner has impermissibly relied on hindsight, using the teachings of Applicants to find the suggestion to combine the alleged teachings of Wong et al. and Ballantyne et al.

As discussed above, the Wong et al. reference is directed to solving the problems associated with a lack of uniformity in accessing stored images. Wong et al., col. 3, lines 17-21. Indeed, the Wong et al. reference is strictly related to the sharing of medical image files with clients through a medical image server. Conversely, the Ballantyne et al. reference is directed to sharing information throughout an internal hospital network, such as administration of medical services, entertainment services, and electronic health records. Ballantyne et al., abstract; col. 1, lines 56-61. The Ballantyne et al. reference is further directed to providing a paperless hospital environment. Ballantyne et al., col. 2, lines 55-63. In fact, the Ballantyne et al. reference does not even disclose *medical diagnostic systems*, but is related to administrative issues, such as security, video entertainment, and general hospital accounting. Ballantyne et al., col. 2, lines 40-45.

In the rejection, the Examiner asserted that the combination would be made to assist the user with processing a service request. However, Wong et al. teach a three-tier system, with the first tier being medical image information systems, the second tier being a medical image server 12, and the third tier being the client systems. Wong et al., col. 7, lines 6-15. Clients access images from the medical image server to ensure that all of the images are uniform. In following the Examiner's assertion, the communication controller 26 of Ballantyne et al. is inserted into the Wong et al. system to assist a user with processing an image request. However, in Wong et al. a single system, the medical image server 12, handles these image requests, and inserting the communication controller 26 of Ballantyne et al. *would not be desirable or even be beneficial to the system*. The addition of the Ballantyne et al. communication controller does not address the problems set forth in the reference. In fact, the insertion of the Ballantyne et al. reference would be contrary to the specific understanding of a skilled artisan in resolving the problems with the uniformity of medical images. Likewise, as the Ballantyne et al. reference does not disclose or suggest *medical diagnostic systems*, and therefore fails to provide any support for the combination.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. As discussed above, the Wong et al. reference relates to uniformity of medical image. Nothing in the reference provides support for the desirability of combining a communications controller into the imaging distribution system. Likewise, the Ballantyne et al. reference is directed to supporting a paperless hospital environment through shared services and does not even disclose or suggest *medical diagnostic systems*. Clearly, the references do not suggest the desirability of the combination. As the references do not support the combination and the Examiner has not pointed to any suggestion or motivation *in the references or in any other art of record* for the proposed combination, the Examiner's alleged combination is unsupported.

Accordingly, because the Examiner has failed to show that the cited references disclose *all* of the claimed elements, as well as a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the cited reference, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, independent claims 1, 16, and 25 and their respective dependent claims are believed to be patentable over Wong et al. in view of Ballantyne et al.

Second Rejection Under 35 U.S.C. § 103

The Examiner rejected claim 14 under 35 U.S. §103(a) as being unpatentable over Wong et al. (U.S. Pat. No. 6,260,021) in view of Ballantyne et al. (U.S. Pat No. 5,867,821) and Official Notice. The Examiner cited Tignor et al. (U.S. Pat No. 4,982,325) to provide support for the Official Notice. The Applicants respectfully traverse Examiner's rejection.


Applicants believe claim 14 is patentable based upon both its dependence on patentable claim 1, and its recited subject matter. In the rejection, the Examiner relied upon the Tignor et al. reference to provide support for the Official Notice that "placing the service request in a queue, and transmitting the service request in accordance with an established schedule." As discussed above, the Wong et al. and the Ballantyne et al. references fail to disclose the all of the recited features of claim 1. The Tignor et al. reference is simply used to provide support for Official Notice taken by the Examiner. The reference is actually directed to an application processor module for interfacing to a database. Tignor et al., col. 3, lines 30-47. As the Tignor et al. reference is unrelated to medical imaging, the reference fails to cure the deficiencies of the Wong et al. and the Ballantyne et al. references discussed above. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of the pending claim 14.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims 1-32. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: 3/17/2003

Respectfully submitted,



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